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08/859,995

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/859,995 05/21/97 HEMPLEMAN

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EXAMINER

LMC1/1006

DRESSLER ROCKEY MILNAMOW AND KATZ
TWO PURDENTIAL PLAZA
SUITE 4700
180 NORTH STETSON AVENUE
CHICAGO IL 60601

KINDERED, A	
ART UNIT	PAPER NUMBER

2776
DATE MAILED:

14

10/06/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/859,995

Applicant(s)

Hempleman et al.

Examiner

Kindred

Group Art Unit

2776

☒ Responsive to communication(s) filed on 7-15-99

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 30-67 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 30-67 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. This action is responsive to communications: Amendment B, filed on 7/15/99.
2. Claims 30-37 are pending. Claims 30, 33, and 35 are independent claims.
3. The present title of the application objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 U.S.C. § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 30-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernard U.S. Patent Number 5,918,213, filed 12/22/95, class 705/26, title "System and method for automated remote previewing and purchasing of music, video, software, and other multimedia products."

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With respect to independent claim 30, Bernard et al. discloses “a graphical display” (“fig. 5 teaches a graphical display”--sheet 5 of 45) “a data base for storage of a media inventory including at least audio items” (“an automated method of selecting, in random order, any of the singular cassettes contained within the cassette library . . .”--column 2, line 18) Bernard et al. discloses “a processor, coupled to the display and the data base with a plurality of instructions executable by the processor wherein some of the instructions present on one part of the display at least a part of a media inventory listing of at least the stored audio items, from which a user can select a plurality of items to be presented and wherein others of the instructions enable the user to select a named, prestored play list and display at least part of the selected list . . . additional instructions enabling the user to select at least one entry from the media inventory listing and insert the selected entry into the selected play list thereby creating a modified play list . . .” (“automated order information can further include location information indicating to automated order picker 4303 . . . retrievers their ordered items from their designated locations updates the inventory to reflect the fact that . . . interactive transaction database . . .”--column 60, line 43). Bernard et al. does not disclose “display at least part of the selected list simultaneously on another part of the display.” It would have been obvious at the time of the invention for one of ordinary skill in the art to have embodied steps similar to the claimed simultaneously step for the following reasons. First, to display a selection from a data base source simultaneously on two or more display will allow those skilled in the art the ability to view and select multiple selections at the same time thereby increasing the odd of getting the selection of choice. Second, displaying

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selection information and instructions simultaneously on separate monitor is well-known in the art and it not expected that patents and product reviews would disclose such fine detail showing such steps as simultaneously displaying selection information.

With respect to dependent claim 31, this claim is rejected on grounds corresponding to the arguments given above for rejected independent claim 30 and is similarly rejected.

With respect to dependent claim 32, **Bernard et al.** discloses "instructions for displaying a plurality of pre-stored play lists and enabling a user to select and execute from the data base one of the displayed play lists independently of the sources of the media entries in the select lists" ("browser through the available titles . . . interface units 104 interactive transaction database 112, and customer service center 108 . . ."--column 18, line 88.

With respect to independent claims 33 and 35 and dependent claims 34 and 36-37, these claims are rejected on grounds corresponding to the arguments given above for rejected independent claim 30 and dependent 31-32. In independent claims 33 and 35 and dependent claims 34 and 36-37, Applicant claims a method which contains steps corresponding to the system of rejected independent claim 30 and dependent claims 31-32.

With respect to independent claims 38, this claim is rejected on grounds corresponding to the arguments given above for rejected independent claims 30 and 33 and is similarly rejected except for the following: **Bernard et al.** discloses "a communication link, coupled to the processor, at least intermitting, for receipt of as least some of the works specified by the updated list . . ." ("automated product purchasing system . . . means for downloading a portion of a

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desired one of said media products . . . indication of customer history and customer music preference . . .”--column 63, line 16).

With respect to dependent claim 39, **Bernard et al.** discloses “responsive to request from the user station for transmitting requested items via the link, to be presented by the first processor and for receiving billing information” (“input from the customer, said input identifying a desired one or more of a plurality of media product the customer would like . . . products without making purchases . . .”--column 63, line 64).

With respect to dependent claims 40, this claim is rejected on grounds corresponding to the arguments given above for rejected independent claim 30 and is similarly rejected.

With respect to dependent claim 41, **Bernard et al.** discloses “whereby items received from the inventory or a local invent at the user station can be written to a removable medium” (“means for obtaining and maintaining a user profile for the customer . . .”--column 61, line 64).

With respect to dependent claim 42, this claim is rejected on grounds corresponding to the arguments given above for rejected independent claim 1 is similarly rejected.

With respect to dependent claim 43, **Bernard et al.** discloses “wherein the user station includes a media reader for incorporate locally read items into the list” (“fig. 19 teaches the reader for reading items into the list”--sheet 19 of 45).

With respect to dependent claim 44, this claim is rejected on grounds corresponding to the arguments given above for rejected independent claims 30 and 38 and is similarly rejected.

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With respect to independent claim 45 and dependent claims 46-50, these claims are rejected on grounds corresponding to the arguments given above for rejected independent claims 30 and 38 and dependent claims 31-32 and are similarly rejected.

With respect to independent claim 51 and dependent claims 50-62, these claims are rejected on grounds corresponding to the arguments given above for rejected independent claims 30 and 38 and dependent claims 31-32, 34 and 35 and 36 are similarly rejected.

With respect to dependent claim 63, Bernar et al. discloses "writing items identified in a selected play list to removable medium for subsequent playback" ("once a selection is made, VRU 104 plays a script which . . . With a listing . . ."--column 16, line 47).

With respect to dependent claims 64-67, these claims are rejected on grounds corresponding to the arguments given above for rejected independent claim 1 and dependent claims 31-32 and 34 and are similarly rejected.

Response to Arguments

6. Applicant's arguments with respect to claim 30-67 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

7. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703)-308-9051 (**formal** communications intended for entry),

Or:

(703)-308-5403 (**informal** communications labeled **PROPOSED** or **DRAFT**).

Hand-delivered responses should be brought to:

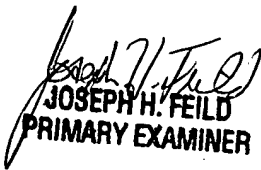
Sixth Floor Receptionist, Crystal Park II, 2121 Crystal Drive, Arlington, VA.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alford Kindred, whose telephone number is (703)-305-3802 and can normally be reached Monday-Friday from 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Razavi, can be reached at (703)-305-4713.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)-305-3900.

AWK


JOSEPH H. FEILD
PRIMARY EXAMINER